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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,822	01/23/2002	Volkmar Schwitzky	103797-238-NP	9521

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

1762

PAPER NUMBER

8

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,822

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/29/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-6 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied,** such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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An appropriately worded abstract is required.

3. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- © Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.

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- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (l) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title is too vague and non-descriptive.

5. The disclosure is objected to because of the following informalities: (1) in [0002], the meaning of "[securities] security" is unclear; (2) [0007], reference to the first claim in the specification in context is improper. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because on line 2 it is unclear relative to what, or of what, durability is increased.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1,4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shenton US 5199744.

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Shenton teaches to apply a tinting lacquer over security paper printed with metallic inks and printed security indicia (= "security feature") to provide colored metallic effects ("emphasize" the metallic ink features), and the lacquer inherently imparts increased durability relative to the uncoated printed surface. Column 2, 40-62.

10. Claims 1,2,4-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Weitzberg et al US 3533176.

Weitzberg et al teaches to apply printed indicia, photographs, and watermarks (= security feature per claims 4-5) to a base sheet material (paper, transparent plastic, etc) and providing a transparent security coating or upper protective (i.e. to increase durability relative the uncoated surface) coating of a lacquer or resin (per claim 6). The transparent/ clear lacquer would inherently emphasize/ optically accentuate underlying features. See column 2, 30-36; column 3, 9-16; column 4, 4-43.

11. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Haghiri et al US 5888624.

Haghiri et al teaches an IC card provided with printed images and security elements such as watermarks, to which is applied a protective lacquer layer

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which provides optical enhancements such as gloss, matte, or grained finishes to underlying features (col. 9, 15-54). The card is lacquered over its printed / major faces, and is also coated only along its edges to prevent splitting (i.e. the edge portions are coated with a second, special protecting lacquer layer 85); see column 9, 15-19.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haghiri et al in view of Weitzberg et al.

Haghiri et al and Weitzberg et al are cited for the same reasons above, which are incorporated herein. Haghiri et al does not explicitly teach a "colorless lacquer". However, use of lacquers per se are taught, and Weitzberg et al teaches a very similar process and security article in which the printed surface is coated with a transparent upper protective (i.e. to increase durability) coating of a lacquer or resin. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Haghiri et al by incorporating the transparent lacquer of Weitzberg et al for the cited lacquers in order to provide the surface with a protective, optically transparent coating which accentuates the printed/ photograph surface.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzberg et al US 3533176 in view of Haghiri et al .

Haghiri et al and Weitzberg et al are cited for the same reasons above, which are incorporated herein. Applying a second coating is not taught by Weitzberg

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et al; however, Haghiri et al teaches to lacquer over printed / major faces of similar articles, and to also provide lacquer coating only along its edges to prevent splitting. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Weitzberg et al by incorporating edge coating using a second coat of lacquer as taught by Haghiri et al to prevent splitting/ improve durability of the edges of the cards.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



**FRED J. PARKER
PRIMARY EXAMINER**

Fred J. Parker

November 6, 2002

10-055822